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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,694	03/14/2001	Anthony J. Kinney	BB1432 US NA	3560

23906 7590 09/27/2002

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EXAMINER

BAUM, STUART F

ART UNIT PAPER NUMBER

1638

DATE MAILED: 09/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/805,694	KINNEY ET AL.
Examiner	Art Unit	
Stuart Baum	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-90 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) ____ is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) 1-90 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____.
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) Other: ____

DETAILED ACTION

Claims 7, 9, 11, 22, and 35 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Correction is required.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, and 5-7 are drawn to a recombinant expression construct to lower Gly m Bd 30K (Soybean vacuolar protein P34), classified in class 800 subclass 290 for example.
- II. Claims 4-7 are drawn to a recombinant expression construct for producing a hypoallergenic soybean, classified in class 800 subclass 290 for example.
- III. Claims 8-14, 16, 25-32, 34-35, 43-49, 53-54, 62-68, 72-73, 80-86 and 88-90 are drawn to a food product, classified in class 426 subclass 531 for example.
- IV. Claims 15, 33, 50, 69, and 87 are drawn to by-products made during the production of oil, classified in class 426 subclass 531 for example.
- V. Claims 17 and 24 are drawn to a method for making a hypoallergenic soybean plant, classified in class 800 subclass 290 for example.
- VI. Claims 18-21, and 24 are drawn to a method for making a hypoallergenic soybean plant comprising making a cross with a hybrid, mutant or transgenic second soybean parent, classified in class 800 subclass 260 for example.

VII. Claims 22-23, 51-52, and 70-71 are drawn to animal feed, classified in class 426 subclass 54 for example.

VIII. Claims 36-38 are drawn to an isolated nucleic acid fragment encoding a soybean Gly m Bd 28K protein, classified in class 536, subclass 23.1 for example.

IX. Claims 55-57 are drawn to an isolated nucleic acid fragment encoding a soybean Gly m 2 protein, classified in class 536, subclass 23.1 for example.

X. Claims 39 and 58 are drawn to a plant protein, classified in class 530 subclass 370 for example.

XI. Claims 40-42 are drawn to a chimeric gene, classified in class 536 subclass 23.1 for example.

XII. Claims 59-61 are drawn to a chimeric gene, classified in class 536 subclass 23.1 for example.

XIII. Claims 74, and 78-79 are drawn to a recombinant expression construct to lower Gly m IA content of a soybean, classified in class 800 subclass 290 for example.

XIV. Claims 75, and 78-79 are drawn to a recombinant expression construct to lower Gly m IB content of a soybean, classified in class 800 subclass 290 for example.

XV. Claims 76, and 78-79 are drawn to a recombinant expression construct to lower rGly m3 content of a soybean, classified in class 800 subclass 290 for example.

NOTE: If Applicant chooses Group XV, Applicant is to elect either SEQ ID NO:11 or SEQ ID NO:13.

XVI. Claims 77-79 are drawn to a recombinant expression construct to lower Glycinin G1 (A1aB1b) content of a soybean, classified in class 800 subclass 290 for example.

Claims 78-79 are generic to Groups XIII-XVI and will be examined to the extent that they read on the elected invention.

Claims 5-7 are generic to Groups I and II and will be examined to the extent that they read on the elected invention.

Claim 24 is generic to Groups V and VI and will be examined to the extent that it reads on the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, VIII, IX, and XI-XVI are unrelated to each other because nucleotide sequences either encoding different proteins or specifying specific expression patterns are structurally distinct chemical compounds and are unrelated to one another, as are different proteins structurally distinct chemical compounds and unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434). This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

Inventions III, IV and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct from each other because the starting materials, method steps and

end products are distinct and unrelated to each other. Invention III is drawn to human food products, Invention IV is drawn to by-products of oil production and Invention VII is drawn to animal feed.

Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the methods of making a hypoallergenic soybean plant use different starting material, method steps and have distinct end products.

The protein of invention X is distinct from the sequences of Inventions I, II, VIII, IX, and XI-XVI because proteins are structurally distinct compounds in comparison to nucleic acid sequences and the protein of Invention X could be made by a process other than the expression of the nucleic acid sequence of Inventions VIII and IX, such as chemical synthesis or purification from the natural source, and the DNA of Inventions VIII and IX may be used for a process other than the production of a protein, such as a nucleic acid hybridization. Lastly, DNA and protein differ in composition, structure and function.

Inventions I, II, VIII-IX, and XI-XVI and Inventions III-VI and Invention VII and Invention X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct from each other because the starting materials, method steps and end products are distinct and unrelated to each other

Each of Inventions I-XVI are capable of being separately made, independently used, and the patentability of one does not render the others obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart Baum whose telephone number is (703) 305-6997. The examiner can normally be reached on Monday-Friday 8:30AM – 5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 or (703) 305-3014 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the legal analyst, Sonya Williams, whose telephone number is (703) 305-2272.

Stuart Baum Ph.D.

September 23, 2002

Elizabeth F. McElwain
ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800